

REMARKS

In the Office Action mailed on May 28, 2003, claim 24 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Schultz in view of Humble and further in view of Small; claim 25 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Schultz in view of Humble and Burton and further in view of Small; claims 26 and 65-77 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schultz in view of Small; and claims 28-29, 50, and 52-53 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schultz in view of Burton and further in view of Small. The foregoing rejections are respectfully traversed.

Claims 24-26, 28-29, 50, 52-53, and 65-77 are pending in the subject application, of which claims 24-26, 28, 50, 52, and 65-67 are independent claims.

Entry of Amendment After Final Rejection:

The Applicant respectfully asserts that the amendments presented herein require only a cursory review by the examiner, and respectfully requests that the examiner enter such amendments.

Amendments to the Claims:

Claims 24-26, 28-29, 50, 52-53, and 65-77 are canceled herein. New claims 78-110 are added herein, leaving only claims 78-110 (claims 78, 87, 89, 98, 100, and 109 are independent claims) as pending in the subject application. Care has been exercised to avoid the introduction of new matter.

Support for the new claims may be found in the Specification at page 8, lines 31-34; page 9, lines 7-8, 14-18, and 30-31; page 16, lines 26-31; page 17, lines 1-5, 11-25, and 26-29; page 18, lines 14-30; page 19, lines 11-29; page 20, line 36 – page 21, line 16; page 21, line 26 – page 22, line 5; page 22, line 18 – page 23, line 4; page 23, line 19 – page 24, line 2; page 27, lines 1-6 and 13-34; and Figures 1, 2, 9A, 9C, 9E-H, 10A-B, 12A-B, 14A-B, 15A-B, 16A-B, 17A-B, and 21A-B.

Rejections of the Claims:

Claims 24-26, 28-29, 50, 52-53, and 65-77 are canceled herein. Therefore, the Applicants respectfully request that the examiner withdraw the rejections thereof.

Lack of Motivation to Combine the References:

On pages 7-8 of the June 4, 2002 Amendment, the Applicants argued that the examiner did not provide any motivation to combine the § 103 references in the December 4, 2001 Office Action. In the October 15, 2002 Office Action, the examiner responded with several older Federal Circuit cases in support of his erroneous position that “the motivation to combine and/or modify the references or reference is based upon evidentiary facts gleaned from the references themselves, as well as from the knowledge generally available to one of ordinary skill in the art.”

In the March 17, 2003 Amendment, the Applicants argued that, pursuant to the current Federal Circuit standard, the examiner must provide actual evidence of the motivation to combine the references, not conclusory statements.

In the examiner's Response to Arguments, beginning on page 67 of the May 28, 2003 Office Action, the examiner asserts that his proffered standard for supporting the motivation to combine the references is “well settled in the law.” The examiner cites *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972) and MPEP § 2144 as supporting the same; however that section of MPEP § 2144 that discusses *In re Linter* has no relevance to the Applicants continuing argument that the examiner has not sufficiently supported the motivation to combine the references. For example, *In re Linter* is discussed in MPEP § 2144 to support the proposition that while there must be motivation to make the claimed invention, there is no requirement that the prior art provide the same reason as the applicant to make the claimed invention.

Clearly, because the examiner does not intend to directly address the Applicants' argument that the examiner is relying on an irrelevant Federal Circuit opinion to avoid complying with his duty to support the motivation to combine the § 103 references with actual evidence, the examiner's reliance upon such a combination must be withdrawn.

New Claims:

Independent claims 78, 89, and 100 recite changing "the predetermined calculation rate." Independent claims 87, 98, and 109 recite changing "a total amount of accumulated points according to a frequency of each customer's transactions." None of the cited references, taken alone or in combination (see arguments against the combination, above), discloses or suggests the same. Therefore, independent claims 78, 87, 89, 98, 100, and 109 are patentably distinguishable over the cited references. In addition, dependent claims 79-86, 88, 90-97, 99, 101-108, and 110 are allowable based in part on their dependency, directly or indirectly, from one of allowable independent claims 78, 87, 89, 98, 100, and 109.


Withdrawal of the foregoing rejections is respectfully requested.

There being no further objections or rejections, it is submitted that the application is in condition for allowance, which action is courteously requested. Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters. If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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